

Application No. 10/619,773

Docket No.: 60680-1802

Amendment dated

Reply to Office Action of September 29, 2005 January 12, 2006

REMARKS

Applicants have carefully reviewed the Office Action mailed January 12, 2006, and thank Examiner Pickard for her detailed review of the pending claims. In response to the Office Action, claims 1, 3, 4, 6-10 and 12-19 remain pending in this application. At least for the reasons set forth below, Applicant respectfully traverses the foregoing rejections. Further, Applicant believes that there are also reasons other than those set forth below why the pending claims are patentable, and reserves the right to set forth those reasons, and to argue for the patentability of claims not explicitly addressed herein, in future papers. Applicants respectfully request reconsideration of the present application in view of the following remarks.

Claim Rejections – 35 U.S.C. § 103

Claims 1, 3-10, 13 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Jelinek* in view of *Terai*. Applicants respectfully traverse the rejection.

NO MOTIVATION TO COMBINE

A case of obviousness requires that there be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See MPEP § 2143; *In re Linter*, 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990), *W.L. Gore and Associates, Inc. v. Garlock, Inc.* 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). Moreover, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

The Examiner has combined the seal 10 of *Jelinek* with the roughened surfaces 21 of *Terai* to reject the claims. As a motivation, the Examiner has provided “to improve adhesion of the elastomer applied thereto.” However, one of skill in the art would recognize

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that the seal 10 of Jelinek would not require any greater adhesion between the backing plate 12 and the layer 22 since the layer 22 includes a main body 24 that is compressed between an end cap 36 and a housing 38. (Column 3, lines 27-32, and FIG. 4). The seal 10 also includes a spacer portion 26 extending from the main body 24 that bindingly contacts a grip surface 50 of the of end cap 36 with an interference fit. Column 3, lines 5-12 "highly finished surface 50 has a diameter slightly larger than the inner diameter of spacer position (sic, portion) 26"). Therefore, the seal 10, as taught in Jelinek, is bindingly restricted on all sides and will not move within the encased location between the end cap 36 and the housing 38.

Accordingly, one of skill in the art will recognize that Jelinek teaches a seal 10 with a layer 22 that is encased within a location such that any movement is restricted. Therefore, one of skill in the art would not seek to combine the seal 10 of Jelinek with any reference, specifically Terai, to provide greater adhesion between the backing plate 12 and the layer 22, since the seal 10 would not benefit from this greater adhesion. Thus, there is no motivation to combine the seal 10 of Jelinek with the roughened surfaces 21 of Terai, as required in *In re Linter*.

PRIMER

Additionally, the Examiner cites the primer 41 of Terai as a teaching for a "textured surface" as recited in claims 13 and 14. However, Terai does not indicate whether the primer 41 produces a textured surface, or a chemical bond, resists the transfer of moisture, or any other means that may increase adhesion. While the disclosure of Terai is unclear, the primer 41 appears to be taught as an alternative to a textured surface. (See FIGS. 10 and 15(b)). Importantly, Applicant is unaware of any primer that provides a textured surface, as the term generally refers to coatings that inhibit the transfer of moisture to permit another coating to adhere.

Accordingly, the Examiner has not established a *prima facie* case of obviousness for independent claim 1 and dependent claims, 3-10, 13 and 14. Therefore, reconsideration and withdrawal of the rejection is respectfully requested.

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Claims 1, 3, 4, 6-10 and 12-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Jelinek* in view of *Fujino* in view of *Terai*. Applicants respectfully traverse the rejection.

ART EQUIVALENT / MOTIVATION TO COMBINE

The Examiner combines *Jelinek*, *Fujino*, and *Terai*. (Office Action dated January 12, 2006, page 3). The Examiner asserts that *Fujino* teaches that the "tapered part of the metal gasket (*Fujino*, column 3, line 34, not numbered) of *Fujino* is an "art equivalent" of the lip 20 of *Jelinek*, and thus a proper substitute. (Office Action dated January 12, 2006, page 3). The Examiner proceeds to provide a motivation for the combination as "[t]herefore, it would have been obvious for one of skill in the art at the time the invention was made to modify the coined angles of *Jelinek* with a coined angle having a gradual reduction in thickness, as such are art equivalent angles as taught by *Fujino*." (*Id.*).

However, *In re Scott* provides that "[e]xpeditents which are functionally equivalent to each other are not necessarily obvious in view of one another." *In re Scott*, 139 USPQ 297, 299 (CCPA 1963), emphasis in original. Therefore, even assuming *arguendo*, that *Fujino* does teach art equivalents, (which Applicant maintains *Fujino* does not, see immediately below), the Examiner has failed to make a showing of obviousness by not providing a reasoned basis for why the tapered part of *Fujino* is obvious in view of the lip 20 of *Jelinek*, as required by *In re Scott*.

Specifically, *Fujino* cannot teach an art equivalent of the lip 20 of *Jelinek* since *Fujino* does not illustrate any portion of a metal gasket that has a lip, such as the lip 20 of *Jelinek* with a sectional profile that includes interior right angles. At best, *Fujino* illustrates, in FIGS. 3I-3III, three tapered parts of a metal gasket A. (Column 3, lines 35-43). *Fujino* does not teach any advantage of the parts shown, discuss any differing adhesion capabilities thereof, or illustrate a lip, such as the lip 20 of *Jelinek*. Accordingly, *Fujino* is silent as to any lip with interior right angles, such as the lip 20 of *Jelinek*, and cannot teach an 'art equivalent' thereof.

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Accordingly, the Examiner has not established a prima facie case of obviousness for independent claims 1 and 12 and dependent claims 3, 4, 6-10 and 13-19. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Claims 1, 3-7, 9, 12, 13, 15-17 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Fujino* in view of *Tera*. Applicants respectfully traverse the rejection.

MOTIVATION TO COMBINE

The Examiner has combined the metal base sheet A of *Fujino* with the roughened surfaces 21 of *Tera* to reject the claims. As a motivation for the proposed combination, the Examiner has provided "to improve adhesion of the elastomer applied thereto." However, as discussed above, *Fujino* does not teach the edge of the metal base sheet A as improving adhesion. In contrast, *Fujino* teaches that FIGS. 3I to 3III are presented to illustrate that the elastic seal member 7 may "be compressed up to the plate thickness of the metal gasket." (Column 3, lines 44-45).

To be clear, *Fujino* presents 28 figures on 12 pages with less than one page of description that is elusive at best, and focused on pouring a liquid gasket 6 into interstitial spaces between mating surfaces. The elastic seal member 7 is provided to berm the liquid gasket 6 (FIG. 17), and does not appear to be taught as providing any sealing function during operation of the device of *Fujino*, as the liquid gasket 6 provides the seal. (See column 1, lines 32-36).

Accordingly, one of skill in the art would appreciate that the elastic seal member 7 taught in *Fujino* need not adhere to the metal base sheet A with any lasting affinity since the adhesion is needed only temporarily until the device of *Fujino* can be assembled and the liquid gasket 6 inserted therein. Therefore, one of skill in the art would not be motivated to combine the teachings of *Fujino* and *Tera* since the device of *Fujino* would not benefit from increased adhesion between the elastic seal member 7 and the metal base sheet A.

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BLUEPRINT

Furthermore, Terai does not teach whether the roughened surfaces 21 would be beneficial on "coined angles formed at said edge of said base sheet," as positively recited in independent claims 1 and 12. Indeed the application of a "textured surface applied to said one or more coined angles," from Applicant's claims is impermissibly used as a blueprint to cobble together the recited claims. ("If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453 at 1457 (Fed Cir. 1998). "Rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability'." *Id.* quoting *Sensonic, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).)

OBVIOUS TO TRY

"As we have said many times, obvious to try is not the standard of 35 USC 103." *In re Antoine*, 195 USPQ 6, 8 (CCPA 1977). The Examiner has combined the metal base sheet A of Fujino with the roughened surfaces 21 of Terai, and stated that "it would have been obvious for one of ordinary skill in the art at the time the invention was made to apply a texture to the coined angles of the base sheet to improve adhesion." However, a close examination of Terai reveals that the roughened surfaces 21 of Terai are only applied to opposing, parallel surface portions. There is no teaching in Terai (or Fujino) that would suggest the likelihood of success in increasing adhesion if the roughened surfaces 21 of Terai were provided on the non-parallel surfaces of the tapered parts that define an outer edge of the metal base sheet A of Fujino. The likelihood of success in combining a textured surface to a coined angle is, however, found in Applicant's specification. Therefore, the Examiner has not established a *prima facie* case of obviousness, as articulated in *In re Antoine*.

Accordingly, the Examiner has not established a *prima facie* case of obviousness for independent claims 1 and 12 as required in *In re Mills*. Dependent claims, 3-7, 9, 13, 15-17

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and 19 are also patentable by being dependent on an allowable base claim. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

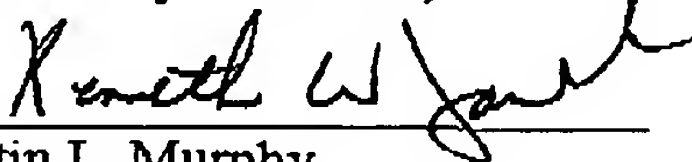
Conclusion

In view of the above, each of the presently pending claims in this application is in immediate condition for allowance. If, however, there are any outstanding issues that can be resolved by telephone conference, the Examiner is earnestly encouraged to telephone the undersigned representative. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes that no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 60680-1802, from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. §1.136 is hereby made, the fee for which should also be charged to this Deposit Account.

Dated: April 12, 2006

Respectfully submitted,

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